

## REMARKS

Claims 1-52 were previously pending in this patent application. Claims 1-52 stand rejected. Accordingly, after this Amendment and Response, Claims 1-52 remain pending in this patent application. Further examination and reconsideration in view of the arguments set forth below is respectfully requested.

### 35 U.S.C. Section 112, First paragraph Rejections

Claims 1-52 stand rejected under 35 U.S.C. Section 112, first paragraph, as based on a disclosure which is not enabling. It was stated that "abutted-pin hierarchical physical design" is critical or essential to the practice of the present invention, but not included in the claims, making the claims not enabled by the disclosure. These rejections are respectfully traversed.

Although it is stated in the Office Action that page 17 of the application teaches that the abutted-pin hierarchical physical design provides solutions to the problems of the traditional hierarchical physical design and provides additional advantages and benefits, it is respectfully asserted that the application does not teach that the "abutted-pin hierarchical physical design" is a "critical" feature as found in In re Mayhew, 527 F. 2d 1229, 188 USPQ 356, (C.C.P.A. 1976). In determining whether a feature is critical, the entire disclosure must be considered. Moreover, features which are merely preferred are not to be considered critical, as noted in In re Goffe, 542 F. 2d 564, 567, 191 USPQ 429, 431 (C.C.P.A. 1976). Limiting an application to the preferred embodiments in the absence of limiting prior art would not serve the

constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended.

In particular, dependent claims 12, 26, 30, and 42 include the limitation "abutted-pin hierarchical physical design". This shows that applicants did not consider the limitation "abutted-pin hierarchical physical design" to be critical, otherwise the Independent Claims 1, 15, 29, and 41 would have included the limitation "abutted-pin hierarchical physical design".

Moreover, at page 13, line 2-4, of the specification, it is clearly stated that the preferred embodiments of the present invention are described in the specification. Additionally, use of the terms "physical design phase" and "physical design information" at page 22 and Figures 9A and 9B demonstrate that the limitation "abutted-pin hierarchical physical design" is not critical to the present invention. In sum, Claims 1-52 are patentable under 35 U.S.C. Section 112, first paragraph, as based on a disclosure which is enabling.

### CONCLUSION

It is respectfully submitted that the above remarks and arguments overcome all rejections. For at least the above-presented reasons, it is respectfully submitted that all remaining claims (Claims 1-52) are now in condition for allowance.

The Examiner is urged to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 23-0085.

Respectfully submitted,

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